



## **PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Alexandria, VA 22313-1450

Dear Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reasons stated below.

Claims 1-32 remain pending in the application with claims 1-14 and 28-32 withdrawn under traversal (petition filed). Reconsideration of the present application is earnestly requested in light of the following remarks. Please note that for brevity, only the primary arguments directed to the independent and some dependent claims are presented, and that additional arguments, e.g., directed to the subject matter of others of the dependent claims, will be presented if and when the case proceeds to Appeal.

**Section 112, First Paragraph, Rejection:**

Claims 15-27 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants note the following clear errors in the Examiner's rejection.

In the Final Office Action and again in the Advisory Action of April 21, 2006, the Examiner asserts that the phrases “particular approver” and “wherein the items for which the particular approver is identified are less than all of the plurality of items specified in said particular purchasing requisition” are not supported in the original specification. However, as explained below, support for these phrases is clearly found in the original specification.

First, the specification clearly describes that an individual approver may be identified as an approver of a sub-set of line items of a particular requisition. For example, paragraph 20 includes the following description: "From the in-box, the approver is able to automatically approve or decline the line items they are responsible for in the requisition." Similarly, paragraph 17 describes, "a system and a method for accepting in-bound order requests with a matrix of approvers with each approver authorized to approve the purchasing of one or more line itemized goods or services." Paragraph 66 states: "The approval graph 520 provides a matrix of identified approvers for a particular requisition. The approval graph 520 contains information about the lines to which each approver is added."

Second, the specification clearly describes that **a particular approver** may only be presented with line items for which they are identified as an approver. For example, the presentation of a sub-set of line items for approval is clearly described in paragraph 67 as follows: "Thus, once a user submits the requisition, the process manager module 310 may send an email to the first set (first in each of the parallel chains) of approvers with only relevant lines items requiring their approval. In other words, **a particular approver only sees the line items that are relevant for him/her**" (emphasis added). Therefore, the phrase "**particular approver**" is explicitly stated in the specification and the fact that not all of the line items of a requisition may require the approval of the particular approver is clearly described ("only relevant line items requiring their approval" and "only sees the line items that are relevant for him/her").

Applicants assert that the above-noted passages and other references to sub-sets of line items, as well as to presenting a partial list of line items to an individual approver, clearly support the phrases objected to by the Examiner. As repeatedly stated by the Board of Patent Appeals & Interferences and by the Court of Appeals for the Federal Circuit, it is well settled that the claimed invention does not have to be described in *ipsis verbis* in order to satisfy the description requirement of §112. *Jacobs v. Lawson*, 214 USPQ 907, 910 (B.P.A.I. 1982). "The subject matter of the claim need not be described literally in order for the disclosure to satisfy the description requirement." *M.P.E.P.* 2163.02. As long as the description "allows persons of ordinary skill in the art to recognize that [the inventors] invented what is claimed" then the description requirement is satisfied. *In re Gosteli*, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). As shown above, one skilled in the art would easily recognize the claimed invention from Applicants' original disclosure. The Examiner's application of the description requirement in the Final Action is "yet another instance of the sort of 'hypertechnical application' of the written description requirement of §112" that has been repeatedly criticized by the court. *In re Driscoll*, 195 USPQ 434, 438 (C.C.P.A. 1977); *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977); *Engineering Development Laboratories v. Radio Corp. of America*, 68 USPQ 238, 241-42 (2d Cir. 1946).

Additionally, the Examiner has the burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the claimed invention. *Ex parte Sorenson*, 3 USPQ2d 1462, 1463 (Bd. Pat. App. & Inter. 1987). The Examiner has not met his burden for presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the claimed invention. The Board has held that "a bare assertion by the Examiner" is insufficient for an assertion that the description requirement is not met. *Sorenson*, 3 USPQ2d at 1463 (Bd. Pat. App. & Inter. 1987). The Examiner has the burden to present evidence or reasons, not just bare assertions, why persons skilled in the art would not recognize support for the claimed invention. *In re Wertheim*, 191 USPQ 90 (CCPA 1976). Here, the Examiner has done nothing more than make a "bare assertion" that particular phrases in claim 15 are not supported in the specification. Thus, the Examiner has clearly failed to establish a *prima facie* rejection under 35 U.S.C. § 112, first paragraph.

For at least the reasons above the § 112, first paragraph, rejection of claims 15-27 is improper and removal thereof is respectfully requested.

### **Section 103(a) Rejection:**

Claims 15-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gardner et al. (U.S. Patent 5,758,327) (hereinafter "Gardner"). **Applicants submit that the Examiner has failed to support a *prima facie* rejection of each of these claims.** Applicants note the following clear errors in the Examiner's rejection.

Regarding independent claim 15, Gardner clearly fails to teach or suggest a line item approval module having the recited limitations. The Examiner states: "Gardner discloses a central computer system, e.g., 10, connected to a distribution provider, e.g., 34, and vendors, e.g., 24, 26, 28 for providing purchasing requests from a workflow catalog database, comprising an electronic purchasing approval/disapproval system comprising a process, e.g. 56, having a line item approval module where at least one approver, e.g., a requestor, approves, e.g., cols. 3-4, line vetoes, only items identified as being fit to be approved. It is noted that, as understood, Gardner comprises a particular approver." However, the language included in the Examiner's rejection is **completely different from Applicants' claim language and does not describe the limitations recited therein.** For example, independent claim 15 does not recite "a line item approval module where at least one approver, e.g., a requestor, approves, ... line vetoes, only items identified as being fit to be approved." Instead, it recites, "a line item approval module, in response to receiving a particular purchase requisition associated with a particular purchasing request, for processing approval of a plurality of items specified in said particular purchasing requisition on a line-by-line basis, wherein one or more approvers are identified for each of the plurality of items, wherein said processing approval comprises presenting to a particular approver only those items for which the particular approver is identified, and wherein the items for which the particular approver is identified are less than all of the plurality of items specified in said particular purchasing requisition." Thus, the Examiner has not stated a *prima facie* rejection.

**Furthermore, the Examiner's summary of cols. 3-4 of Gardner is incorrect.** For example, the Examiner seems to equate "one or more approvers are identified for each of the plurality of items" as recited in Applicants' claim 15 to a "requestor" in Gardner. However, there is nothing in Gardner to teach or suggest that a requestor in Gardner is also an approver of the requisition he or she has submitted. Instead, column 3, lines 48-52, states: "If the requisition file includes more than one requested item for purchase, there may be line vetoes of some items and line approvals of other items. Files having line vetoes are preferably redirected to the requestor, who can then reconsider the purchase of the remaining items." That is, if any line items are vetoed by an authorized approver, the requestor may decide not to pursue ordering those items, such as by resubmitting his or her request. Furthermore, the Examiner's characterization that, "an approver approves, e.g., cols. 3-4, line vetoes, only items identified as being fit to be approved" is completely unsupported by Gardner. There is nothing in Gardner that describes an approver approving or line vetoing only items identified as being fit to be approved.

Gardner describes his authorization process in col. 3, lines 32-43, as follows:

The appropriate company-specific requisition rules are selected according to the affiliation of the requestor with one of the companies. The requisition rules include an authorization matrix. The authorization matrix dictates the individuals within the company that must sign in order to provide proper approval of the requisition. The requisition file and its attachments are routed through the authorization process according to a routing engine that identifies the person-to-person sequence. The requisition rules may include information related to delegation of the required authorization signature and may include designation of agents for delegating signatures. (emphasis added).

Here, Gardner clearly describes that a requisition is routed, in its entirety, to a sequence of approvers. There is nothing in columns 3-4 or elsewhere in Gardner that teaches or suggests that anything

other than an entire requisition, whether in a single document/file or in a folder containing multiple sub-requisitions, is routed to any of the approvers in the person-to-person sequence dictated by the authorization matrix, as described in the citation above. There is nothing in cols. 3-4, or elsewhere in Gardner, that teaches or suggests presenting to a particular approver only those items for which the particular approver is identified, as recited in Applicants' claim 15.

The Examiner does not address the "process manager ..." limitation of claim 15 other than to admit that Gardner does not disclose the term "process manager" and to take Official Notice that, "process managers in data application comprising graph functions have been common knowledge in the computer database art, as is electronic mail delivery." The Examiner asserts that to have provided such for Gardner would have been obvious to one of ordinary skill in the art. Applicants traverse. First, claim 15 does not recite a process manager comprising graph functions. Instead, claim 15 recites "a process manager for managing the approval process in said line item approval module." Since the Examiner did not take Official Notice of the particular type of process manager recited in claim 15, the Examiner has not stated a *prima facie* rejection. Second, even if a process manager as recited in claim 15 was known in the prior art, the Examiner did not state any motivation to modify the system of Gardner to include such a process manager. Thus, the Examiner has further failed to state a *prima facie* rejection. Third, although Applicants traversed the Examiner's Official Notice, the Examiner failed to provide documentary evidence in support of his Official Notice. According to M.P.E.P. § 2144.03 and *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001), if the Examiner fails to provide documentary support following traversal of an Official Notice, **the rejection cannot be maintained.**

To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974); MPEP 2143.03. Furthermore, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so in the prior art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As shown above, the Examiner has not shown that all limitations of Applicants' claimed invention are taught or suggested by the prior art. Nor did the Examiner provide any motivation to modify the teachings of Gardner. Therefore, the Examiner has clearly failed to establish a *prima facie* rejection of claim 15 under 35 U.S.C. § 103(a).

For at least the reasons above, the rejection of claim 15 is not supported by the cited art and removal thereof is respectfully requested.

The Examiner's rejection of many of the dependent claims is additionally erroneous. For example, in regard to claim 16, the Examiner admits that Gardner does not disclose the term "process manager" or a graph. The Examiner takes Official Notice that, "process managers in data application comprising graph functions have been common knowledge in the computer database art, as is electronic mail delivery." The Examiner asserts that to have provided such for Gardner would have been obvious to one of ordinary skill in the art. Applicants traverse. First, claim 16 does not recite a process manager comprising graph functions. Instead, claim 16 recites "wherein said process manager comprises a graph generator for generating an approval graph of identified approvers of the plurality of items specified in said particular purchasing requisition, and wherein for each identified approver said approval graph indicates the items for which the approver is identified." Since the Examiner did not take Official Notice of the particular limitations recited in claim 16, the Examiner has not stated a *prima facie* rejection. Second, even if process managers comprising graph functions were known in the prior art, the Examiner did not state any motivation to modify the system of Gardner to include a process manager comprises a graph generator. Thus, the Examiner has further failed to state a *prima facie* rejection. Third, although Applicants traversed the Examiner's Official Notice, the Examiner failed to provide documentary evidence in support of his Official Notice. According to M.P.E.P. § 2144.03 and *In re Zurko*, 258 F.3d

1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001), if the Examiner fails to provide documentary support following traversal of an Official Notice, the rejection cannot be maintained.

For at least the reasons above, the rejection of claim 16 is not supported by the cited art and removal thereof is respectfully requested.

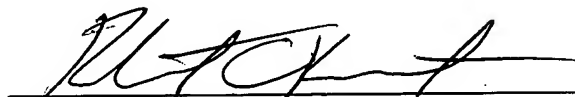
In regard to claims 17-27, the Examiner did not even attempt to address the specific limitations of each of these claims. Therefore, no *prima facie* rejection under 35 U.S.C. § 103(a) has been stated for any of claims 17-27. For at least this reason, the rejection of claims 17-27 is not supported by the cited art and removal thereof is respectfully requested.

In light of the foregoing remarks, Applicants submit the application is in condition for allowance, and prompt notice to that effect is respectfully requested. If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 501505/5181-66200/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Notice of Appeal

Respectfully submitted,



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